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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,542	08/19/2003	Linda J. Flammer	IFF-25-1	4278

48080 7590 07/17/2006

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EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,542

Applicant(s)

FLAMMER ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5,8-11,17-19 and 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,12-16 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/19/03; 2/11/04; 7/12/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claims 1-26 are pending in this application filed 8/19/03, which is a CIP of SN 10/067,596, filed 2/5/02, now abandoned.

Election/Restrictions

1. Applicant's election of Group I, Claims 1-16 and 20, in the reply filed on 2/2/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Acknowledgment is made of the response to the election of species requirement. The elected species are: C7-C12 alkanoic acid vanillamide as a cooling sensate enhancer and C1-C3 alkyl or dialkyl-N-substituted menthane carboxamide as a cooling sensate material.

3. Claims readable on the elected species are 1-4, 6, 7, 12-16 and 20. Claims 5, 8-11, 17-19 and 21-26 have been withdrawn from consideration as directed to the non-elected invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-4, 6, 7, 12-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu et al. (EP 1 121 927) in view of either Beilharz et al. (US 5,494,675) or Rapaport (US 5,730,965) or Michael (US 2001/0043912), all of record.

Nakatsu et al. teach sensate compositions comprising at least one cooling sensate, at least one warming sensate and at least one tingling sensate. See Abstract. The cooling sensates of Nakatsu et al. include N-ethyl-2-isopropyl-5-methylcyclohexane carboxamide and the warming sensates include nonyl acid vanillylamide. See p. 4, lines 21-40. Each of the sensates is present at concentrations from 0.001% to 20%. See p.4, lines 21-22. The sensate composition of Nakatsu et al. are used in personal care compositions such as shampoos, hair tonics and other hair care products. See p. 5, lines 30-34. The Nakatsu reference does not teach the claimed anti-dandruff component. However, it is conventional to employ anti-dandruff compounds in shampoos because dandruff is a widespread cosmetic problem. See Beilharz et al. at col. 1; Rapaport at Abstract; Michael at p. 9-10, lines 0107-0108. Further, Michael teaches ethyl menthane carboxamide of Claim 20 as sensate material for using in hair treatment compositions. See p. 9, lines 0105-0106. Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to employ anti-dandruff compounds of Beilharz et al., Rapaport or Michael in the shampoo compositions of Nakatsu et al. with a reasonable expectation of beneficial results such as providing a shampoo composition having an anti-dandruff effect in order to treat a widespread cosmetic problem. With respect to Claim 14, the recited fragrance

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components are conventionally used in hair cosmetic and it would have been obvious and within the skill of the art to select the optimal fragrance composition in order to obtain the desired fragrancing effect. With respect to the claimed weight ratios of the ingredients, the determination of optimal or workable ratios of anti-dandruff agent:cooling sensate:cooling sensate enhancer by routine experimentation is obvious absent showing of criticality of the claimed ratios. One having ordinary skill in the art would have been motivated to do this to obtain the desired cooling and anti-dandruff properties of the composition.

6. Claims 1-4, 6, 7, 12-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. (WO 99/39683), supplied by the Applicant, in view of Nakatsu et al. (EP 1 121 927).

Hu et al. teach anti-dandruff shampoo compositions comprising from about 0.1% to about 10% by weight of an antimicrobial compound, which acts as anti-dandruff agent, and from about 0.01% to about 5% by weight of a cool-feeling agent. See Abstract; pp. 12-14; p. 18. The cool-feeling agents of Hu et al. include carboxamides such as N-substituted-p-methane-3-carboxamide. See p. 18, lines 21-29. The compositions of Hu et al. contain conventional fragrances and perfumes. See p. 38, line 7; Examples. The shampoos of Hu et al. are applied to the scalp and provide an improved deposition of antimicrobial agents as well as impart a refreshing feeling to the scalp. See pp. 1-2. Hu et al. do not teach the claimed cooling sensate enhancer material. However, Nakatsu et al. teach sensate compositions for use in cosmetic

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compositions, including shampoos, comprising at least one cooling sensate, at least one warming sensate and at least one tingling sensate as discussed above. The warming sensates of Nakatsu et al. include nonyl acid vanillylamide of the instant claims. See above. Nakatsu et al. teach that the sensations associated with warming sensates prolong and enhance the cooling effects of cooling sensates. See p. 3, lines 23-25. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the shampoo compositions of Hu et al. such that to use warming sensates such as nonyl acid vanillylamide. One having ordinary skill in the art would have been motivated to do this to obtain the enhanced and prolonged cooling effect as suggested by Nakatsu et al. With respect to the claimed weight ratios of the ingredients, the determination of optimal or workable ratios of anti-dandruff agent:cooling sensate:cooling sensate enhancer by routine experimentation is obvious absent showing of criticality of the claimed ratios. One having ordinary skill in the art would have been motivated to do this to obtain the desired cooling and anti-dandruff properties of the composition.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

7. No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm, M.S., J.D.
Patent Examiner
6/27/06


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER